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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,756	11/16/2000	Lorin Evan Ullmann	AUS9-2000-0707-US1	5037

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,756

Applicant(s)

ULLMANN ET AL.

Examiner

Mohammad A Siddiqi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 are presented for examination.

Response to Arguments

1. In view of the Applicants arguments in the Appeal Brief were found persuasive filed on 11/09/2004, PROSECUTION IS HEREBY REOPENED.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 4-6, 8-10, 13-15, 17-19, and 22, 23, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Klein et al. (96,496,853) (hereinafter Klein).

4. As per claims 1, 10, and 19, Klein discloses a method, computer-readable medium, and system for creating thread-of-discussion electronic mail messages for chained electronic mail messages in an electronic mail system, said method comprising the steps of (col 5, lines 16-50):

parsing text of the body of a single chained electronic mail message into discussion entries (unique to the response message, col 5, lines 16-35 and col 9, lines 50-67), said parsing being performed by finding delimiters and message segment indicators within the text of the chained electronic mail message which indicate the beginning and ending of two or more discussion entries wherein each discussion entry represents quoted text or content produced during a previously-performed message forward or message reply operation (col 5, lines 16-35 and col 9, lines 50-67);

sorting said discussion entries into a preferred order (col 7, lines 55-59);

reducing the discussion entries to discussion information by eliminating redundant (col 3, lines 55-60) and unnecessary information from said discussion entries (unique to the response message, col 5, lines 16-35 and col 9, lines 50-67); and

outputting the sorted, reduced discussion entries into a single message having a thread-of-discussion message format (col 7, lines 20-59).

5. As per claims 4, 13, and 22, Klein discloses wherein said step of sorting said discussion entries into a preferred order comprises sorting the discussion entries into a first-to-last order based upon timestamps associated with the discussion entries (col 5, lines 17-35 and col 7, lines 55-59).

6. As per claims 5,14, and 23, Klein discloses wherein said step of sorting said discussion entries into a preferred order comprises sorting the discussion entries into a last-to-first order based upon timestamps associated with the discussion entries (Fig 2Dcol 5, lines 17-35 and col 7, lines 55-59).

7. As per claims 6 and 15, Klein discloses step of reducing the discussion entries to discussion information comprises removing extraneous non-discussion field and formatting information from the discussion entries (col 3, lines 55-63 and col 5).

8. As per claims 8,17, and 26, Klein discloses of merging text from a chained electronic mail message with text from other chained electronic messages associated with a common chain group (col 8, lines 42-60).

9. As per claims 9 and 18, Klein discloses further comprising a step of automatically addressing a new electronic mail message to one or more of members of an associated chain group, said new electronic mail message containing said sorted, reduced discussion entries in a thread-of-discussion format(col 7, lines 52-67, col 8, lines 42-60, and col 5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 16, 24, 25 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (6,496,853) in view of Comer et al.

(Conversion-Based Mail by Douglas E. Comer and Larry L. Peterson, November 1986, ACM Transactions) (hereinafter Comer).

12. As per claims 7, 16, and 25, Klein discloses step of outputting the sorted, reduced discussion entries into a thread-of-discussion message

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format further comprises replacing full electronic mail addresses for authors of said discussion entries (sender, recipients, col 5, lines 16-35 and col 9, lines 25-27). Klein does not explicitly disclose the short names or abbreviations associated with the full electronic mail addresses. However, Comer discloses the short names or abbreviations associated with the full electronic mail addresses (page 301, second paragraph). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Klein and Comer. The motivation would have been develop an interface to accept and display names in a form that can be defined by the user.

13. As per claim 24, the claim is rejected for the same reasons as claim 7 above. In addition, Comer discloses message output creator further comprises a short name label creator for substituting full electronic mail addresses associated with said discussion entries with short names associated with said full electronic mail addresses (Pages 300-301).

14. As per claim 27, the claim is rejected for the same reasons as claim 7 above. In addition, Comer discloses message output creator further comprises and automatic message address generator for automatically

addressing a new electronic message to one or more members of a chain group (Pages 300-301).

15. Claims 2, 3, 11, 12, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (6,496,853) in view of Ankireddipally et al. (6,772,216) (hereinafter Ankireddipally).

16. As per claims 2, 11, and 20, Klein discloses step of parsing the text of a chained electronic mail message into discussion entries comprises parsing an electronic message (col 5, lines 16-35 and col 9, lines 50-67).

Klein does not explicitly disclose electronic message is a Simple Mail Transfer Protocol message. However, Ankireddipally discloses electronic message is a Simple Mail Transfer Protocol message (col 15, lines 57-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Klein and Ankireddipally. The motivation would have been to keeps the process regulated and standardized between mail servers by using SMTP protocol.

17. As per claims 3, 12, and 21, Klein discloses step of parsing the text of a chained electronic mail message into discussion entries comprises parsing an electronic message (col 5, lines 16-35 and col 9, lines 50-67). Klein does not explicitly disclose Hyper Text Markup Language message. However,

Ankireddipally discloses Hyper Text Markup Language message (col 14, lines 57-67). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Klein and Ankireddipally. The motivation would have been using a universal common document language for the World Wide Web because text in an HTML document can be translated on-the-fly by a machine translator.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent teaches 6,343,601 Pre Test Electronic mail process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS

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